REMARKS

The preceding amendments and following remarks are submitted as a full and complete response to the Office Action issued on March 24, 2008. Claims 1, 3 and 4 have been amended. Support for the amendments may be found in the original claims. No new matter has been added. Currently, claims 1 and 3-19 are pending in this application.

Claims 6 and 7 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office asserted that the term "exactly registered" in claim 6 is unclear because it would be impossible to achieve. Claim 7 was rejected because it depends from claim 6. Applicant respectfully traverses.

Applicant notes that the rejection is not a proper 35 U.S.C. §112, second paragraph rejection because the Office has not alleged that the claim is indefinite. An allegation that a method step is "impossible to achieve" (Instant Office Action) is properly a 35 U.S.C. §112, first paragraph rejection. Even so, claim 6 meets the requirements of 35 U.S.C. §112, first and second paragraphs because the specification provides a definition of "exactly registered" at paragraph 0031, namely, "the security features [are] in exact register [if] they lie within a still acceptable tolerance range." One of ordinary skill in the art would understand how to calculate an acceptable tolerance range, and how to use a tolerance group to to achieve placement of security features in this tolerance range, i.e., exact register in view of the present specification. Thus, claims 6 and 7 are definite and the rejection is improper. Accordingly, Applicant requests that the rejection be withdrawn, and claims 6 and 7 be allowed.

Claims 12-19 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,093,184 to Edwards. Applicant respectfully traverses as Edwards fails to disclose each and every element of the present invention.

Claim 12, from which claims 13-19 depend, recites a layer compound (6) comprising two carrier foils (100, 200) each having at least one security feature covering the respective carrier foil only partially, characterized in that the two carrier foils are joined to each other in such a way, that the security features are disposed in register to each other.

Edwards is directed to a security paper comprising at least one elongated security element being partially embedded within the paper. The security element comprises a plurality of layers including a support layer and metallic regions such that when the exposed portions of the security element are viewed in the reflected light there are visible at least two metallic

areas which form repeating patterns along the length of the element. Edwards, abstract; column 2, lines 11 to 27.

Edwards shows in Figure 12 a security element that is formed by laminating back to back identical security elements as illustrated in Figure 11 (column 8, lines 6 to 30 of Edwards). Even if it may appear from Figure 12 that the two security elements are disposed such that the metallized areas 12 are in some sort of alignment to each other, a person skilled in the art would not understand Edwards to disclose two carrier foils are joined such that the security features are disposed in register to each other, in order to exhibit some optical effects. There is simply no disclosure that the security elements be registered with each other. In fact, it is not even necessary to provide registered security elements in Edwards, since the intermediate continuous metallic layers 14 may be opaque (column 7, line 56 of Edwards) to the effect that the metallized areas 12 of the two the security elements cannot interact. Further, even if Figure 12 of Edwards were interpreted to somehow disclose the registration of security elements claimed in claim 12, the disclosure of Edwards fails to explain how to register the security element and is therefore not enabling. For this second independent reason, Edwards cannot anticipate claim 12.

Thus, Edwards fails to disclose each and every element of claim 12, from which claims 13-19 depend. Further, the Office Action has failed to provide the requisite specificity for the Applicant to understand which elements of Edwards are alleged to anticipate which elements of claim 12. Accordingly, Applicant submits that the rejection is improper and requests that it be withdrawn. Applicant requests that claims 12-19 be passed to issue.

Claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Edwards patent in view of U.S. Patent 3,601,913 to Pollock and/or U.S. Patent 4,536,016 to Solomon et al. Applicant respectfully traverses, as the cited art does not disclose or suggest each and every element of amended claim 1, from which claims 3-11 depend. Applicant notes that this rejection fails to specify what Edwards, the primary reference, does not teach, and that this rejection improperly uses "and/or," which refers to a multiplicity of combinations, each of which would each require a separate rejection.

Claim 1, from which claims 3-11 depend, recites a method for producing a layer compound (6) with at least two security features disposed in register to each other. The method includes providing a first carrier foil (100) with at least one first security feature and

first register marks. The method also includes providing a second carrier foil (200) with at least one second security feature and second register marks, and joining the first carrier foil to the second carrier foil, at least one of the two carrier foils being under tensile stress and at least one of the second or the first carrier foil being controlled in longitudinal direction and transverse direction with the help of the first and second register marks in such a way, that a layer compound is the result, in which the first and second security features are disposed in register to each other, whereas the controlling of at least one of the second carrier foil (200) or the first carrier foil (100) is effected by stretching the carrier foil in longitudinal direction of the carrier foil.

In contrast, Pollock relates to process of manufacturing a magnetic identification card by moving the identification card 20 between two pressure rollers 23, 24 so that plastic material 21a and 22a cover the upper and lower faces of card 20, respectively (Figure 1, col. 2, lines 34 to 37 of Pollock). In order to laminate the plastic materials 21a and 22a, which have respective magnetic M1 and M2 impregnated thereon, with the identification card 20 in proper alignment, the plastic material may be provided with sprocket holes engageable with sprockets 23a, 24a so that the indexing of the materials in conjunction with the movement of the identification card 20 through the rollers 23,24 (column 2, lines 62 to 69 of Pollock). The two plastic materials 21 a, 22a are heat sealed by heat sealing elements 26, 27 such that the card is encased in the plastic material (column 2, line 69 to column 3, line 3 of Pollock).

However, Pollock does not disclose or suggest to join the two plastic materials and the card such that the magnetic security features M1 and M2 are disposed in register to each other, as required by amended claim 1. To the contrary, the claimed registered arrangement of first and second security features would, in fact, not be required within the technical context of Pollock, since the security features M1, M2 are disposed on different sides of the card 20 and therefore do not exhibit any kind of interaction that might be effected by the relative positions of these security features M1, M2 to each other.

Further, Pollock does not disclose or suggest to effect the controlling of one of the two plastic materials by stretching the plastic material in longitudinal direction. In fact, Pollock provides sprocket holes to ensure that the plastic materials 21 a, 22a may be coordinated with the ovement of the card 20, i.e. that the plastic materials may be laminated at predetermined positions of the card. The sprocket holes thus serve for "controlling" the position of the two plastic materials 21 a, 22a in relation to the card. Interestingly, Pollock does not explain how

the card 20 is actually moved. However, it may be assumed that the sprockets 23a, 24a engage the sprocket holes in order to move the card. Pollock does not disclose or suggest to use the plastic materials as such for controlling a registered arrangement and that such controlling may be effected by longitudinally stretching one of theses foils.

Solomon refers to plastic banknotes having a window within which an optically variable device may be incorporated. The plastic banknotes are produced from a laminate 18 coated such that in the coating a transparent window is left into which the security device will be later inserted (col. 4, lines 13 to 20 of Solomon). During the manufacturing process, the transparent windows of the banknotes are aligned transversely across a printed sheet 24, such that a separate transfer foil 30 is provided for each banknote (col. 4, lines 27 to 40 of Solomon). Thereafter, the security element is transferred to laminate 18 whereas a longitudinal registration of the transfer devices within the windows is ensured. In order to ensure the alignment between pads 29 and the windows of the notes that are provided on the surface of the upper role in line with each transfer foil 30, a detector 34 detects a series of registration marks printed on the edge of sheet 24 in order to control the roller 26 (col. 4, line 65 to col. 5, line 17 of Solomon).

Solomon thus teaches to use one separate security element which is not part of the foils to be connected to each other, but is present on a separate foil to be disposed by a transfer. In fact, this transfer foil does not become part of the multilayer laminate such that it is not necessary in the context of Solomon's teaching to join two foils such that respective security features on these foils are disposed in register to each other, as required by amended independent claim 1. A skilled artisan considering the above sketched teaching of Edwards will not obtain any hint or suggestion from Pollock and/or Solomon as to join two carrier foils such that respective security features are disposed in register to each other by stretching one of the foils in longitudinal direction. Thus, the combination of cited prior art fails to disclsoe or suggest each and every element of claims 1 and 3-11, and the rejection is improper. Accordingly, Applicant requests that claims 1 and 3-11 be allowed.

Claims 12-19 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 16, 18-20 and 24 of copending Application No. 2005/0012326. Applicant submits that it is premature to comment on a preliminary double patenting objection referring to applications that are still under examination and whose scope of protection is currently not conceivable.

In view of the foregoing amendment and remarks presented herein, Applicant respectfully requests withdrawal of the rejections and allowance of all pending claims.

A Notice of Allowance is respectfully solicited.

If any extension of time is required in connection with the filing of this paper and has not been requested separately, such extension is hereby requested.

The Commissioner is hereby authorized to charge any fees and to credit any overpayments that may be required by this paper under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

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